ESTTA Tracking number:

ESTTA753469

Filing date:

date: 06/20/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Swiff-Train Company, LLC		
Entity	LLC	Citizenship	Texas
Address	2500 Agnes Street Corpus Christi, TX 78469 UNITED STATES		

Attorney informa-	Joseph W. Berenato, III
tion	Berenato & White, LLC
	6550 Rock Spring Drive, Ste. 240
	Bethesda, MD 20817
	UNITED STATES
	jberenato@bw-iplaw.com, uspto.filings@bw-iplaw.com Phone:2403304520

Registration Subject to Cancellation

Registration No	3980003	Registration date	06/21/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	Norbord Industries Inc. 1 Toronto Street, Suite 600 Toronto, Ontario, M5C2W4 CANADA		

Goods/Services Subject to Cancellation

Class 019. First Use: 2009/06/01 First Use In Commerce: 2009/06/01

All goods and services in the class are cancelled, namely: Structural wood floor panels, namely, oriented strand board

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86810832	Application Date	11/05/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PINNACLE FLOORING		

Design Mark	PINNACLE FLOORING		
Description of Mark	NONE		
Goods/Services	Class 019. First use: First Use: 0 First Use In Commerce: 0 Flooring not of metal; engineered flooring not of metal; hardwood flooring; wholesale distributorship featuring flooring not of metal, engineered flooring not of metal and hardwood flooring; retail store services featuring flooring not of metal, engineered flooring not of metal and hardwood flooring		
U.S. Application No.	86810840	Application Date	11/05/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PINNACLE		
Design Mark	PINN	IAC	LE
Description of Mark	NONE		
Goods/Services	Class 019. First use: First Use: 0 First Use In Commerce: 0 Flooring not of metal; engineered flooring not of metal; hardwood flooring; wholesale distributorship featuring flooring not of metal, engineered flooring not of metal and hardwood flooring; retail store services featuring flooring not of metal, engineered flooring not of metal and hardwood flooring		

Attachments	86810832#TMSN.png(bytes) 86810840#TMSN.png(bytes) Petition.pdf(241737 bytes) Exhibit 1.pdf(2188738 bytes)
	Exhibit 2.pdf(137748 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/
Name	Joseph W. Berenato, III
Date	06/20/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SWIFF-TRAIN CO., LLC	:
Petitioner,	: Cancellation No
	:
v.	: Registration No. 3980003
	:
NORBORD INDUSTRIES INC.,	:
	:
Registrant.	:
	:

PETITION FOR CANCELLATION

Box TTAB - FEE Commissioner for Trademarks P.O. Box 1451 Alexandria, Virginia 22313-1451

Swiff-Train Company, LLC, a limited liability company legally organized under the laws of Texas, having an address at 2500 Agnes Street, Corpus Christi, TX 78469 ("Petitioner") believes it is and will continue to be damaged by registration of the mark PINNACLE, Registration No. 3980003 ("'003 Registration"), for "structural wood floor panels, namely, oriented strand board" in International Class 019, which is believed to be owned by Norbord Industries Inc., a Canadian corporation, having an address at 1 Toronto Street, Suite 600, Toronto, Ontario, CANADA M5C 2W4 ("Respondent").

Petitioner seeks cancellation of the '003 Registration, pursuant to the Trademark Act of 1946 ("Trademark Act").

The grounds for cancellation are as follows:

1. Petitioner filed on November 5, 2015 in the U.S. Patent and Trademark Office an application to register the mark PINNACLE, Serial No. 86/810,840 ("840 Application") for

"flooring not of metal; engineered flooring not of metal; hardwood flooring; wholesale distributorship featuring flooring not of metal, engineered flooring not of metal and hardwood flooring; retail store services featuring flooring not of metal, engineered flooring not of metal and hardwood flooring" in International Class 019.

- 2. Petitioner filed on November 5, 2015 in the U.S. Patent and Trademark Office an application to register the mark PINNACLE FLOORING, Serial No. 86/810,832 ("832 Application") for "flooring not of metal; engineered flooring not of metal; hardwood flooring; wholesale distributorship featuring flooring not of metal, engineered flooring not of metal and hardwood flooring; retail store services featuring flooring not of metal, engineered flooring not of metal and hardwood flooring" in International Class 019.
- 3. Petitioner's '840 and '832 Applications were refused registration by the United States Patent and Trademark Office (the "Trademark Office") on the grounds of likelihood of confusion with the '003 Registration for PINNACLE pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as set forth in Office Actions issued on March 3, 2016.
- 4. Petitioner is involved in the business of distributing and selling flooring, such as carpet and padding, cork flooring, hardwood flooring, engineered wood flooring, laminate flooring, and tile, throughout the U.S. and internationally, including in Canada.
- 5. On October 30, 2015, Petitioner acquired all intellectual property assets, and the associated good will, of Pinnacle Interior Elements, Ltd., including all registered and unregistered trademarks and service marks, domain names, web sites, and the like. Pinnacle Interior Elements, Ltd. was founded in 1999, was located at 1434 Patton Place, Carrollton, Texas 750.07, and distributed and sold hardwood flooring products to the North American market, including in the United States and Canada, under the brand and marks PINNACLE INTERIOR

ELEMENTS, PINNACLE FLOORING, and PINNACLE. Pinnacle Interior Elements, Ltd. and Petitioner have continuously used the marks PINNACLE INTERIOR ELEMENTS, PINNACLE FLOORING, and PINNACLE on or in association with hardwood and engineered wooden flooring since 1999 and at least since 2004. See Exhibit 1.

- 6. As a result of the acquisition, Petitioner distributes and sells wooden flooring, including solid wood flooring and engineered wood flooring, under the marks PINNACLE INTERIOR ELEMENTS, PINNACLE FLOORING, and PINNACLE. In addition, Petitioner and its predecessor-in-interest maintains and has maintained a website at http://www.pinnacleinteriorelements.net, where consumers can view products, product specifications, product information and locate dealers for the wood flooring products sold under the marks PINNACLE INTERIOR ELEMENTS, PINNACLE FLOORING, PINNACLE (see Exhibits 1, 2).
- 7. To the best of Petitioner's knowledge, the '003 Registration is owned by Respondent.
- 8. Upon information and belief, Respondent is a Canadian corporation, with an address at 1 Toronto Street, Suite 600, Toronto, Ontario, CANADA M5C2W4.
- 9. Upon information and belief, Respondent is a manufacturer of oriented strand board sold under the mark PINNACLE.
- 10. The '003 Registration was granted June 21, 2011, on application Serial No. 77/847,854 ('854 Application) filed October 13, 2009.
- 11. The '003 Registration is not incontestable under Section 15.
- 12. The '854 Application claims priority of Canadian Registration No. TMA781,019.

13. Respondent has alleged June 1, 2009, as the date of first use in commerce of the mark of the '003 Registration. Upon information and belief, Registrant made no use of the mark of the '003 Registration prior to June 1, 2009.

COUNT I – PRIORITY AND LIKELIHOOD OF CONFUSION

- 14. The allegations of paragraphs 1-13 are incorporated herein.
- 15. Petitioner's and its predecessor-in-interest's use of the PINNACLE, PINNACLE FLOORING and PINNACLE INTERIOR ELEMENTS marks predates the filing date of the '854 Application that resulted in the '003 Registration.
- 16. Petitioner has priority in the marks PINNACLE, PINNACLE FLOORING and PINNACLE INTERIOR ELEMENTS as applied to wooden flooring products in International Class 19.
- 17. Petitioner's and its predecessor-in-interest's proprietary rights in the PINNACLE, PINNACLE FLOORING and PINNACLE INTERIOR ELEMENTS marks are superior to Respondent's rights in the '003 Registration, as evidenced by Petitioner's and its predecessor's prior use of the PINNACLE, PINNACLE FLOORING and PINNACLE INTERIOR ELEMENTS marks on or in association with wooden flooring products.
- 18. Upon information and belief, Petitioner has been or will be damaged by Respondent's use of the mark of the '003 Registration, because such use will support and assist Respondent in the confusing and misleading use of its mark, and will give color of exclusive statutory rights in Respondent in violation and derogation of the prior superior rights of Petitioner.

19. In view of the similarity of the respective marks, channels of trade, and goods offered for

sale by the respective parties, Respondent's '003 Registration so resembles Petitioner's

PINNACLE, PINNACLE FLOORING and PINNACLE INTERIOR ELEMENTS marks,

previously used in the United States, and not abandoned, as to be likely to cause confusion, or to

cause mistake, or to deceive as to source by suggesting that Respondent's goods are associated

with or approved, endorsed, affiliated, authorized or sponsored by Petitioner.

WHEREFORE, Petitioner requests that its Petition for Cancellation be granted and that

the '003 Registration be stricken from the Principal Register.

Please charge any additional fees incurred by Petitioner in conjunction with this

proceeding to Deposit Account No. 504717.

Respectfully submitted,

/Joseph W. Berenato, III/

Joseph W. Berenato, III

Attorney for Petitioner

Berenato & White, LLC

6550 Rock Spring Drive

Suite 240

Bethesda, Maryland 20817

Direct: (240) 330-4520

Telephone: (301) 896-0600

Facsimile: (301) 896-0607

5

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Petition For Cancellation upon Registrant by depositing one copy thereof in first-class postage prepaid on June 20, 2016, addressed as follows:

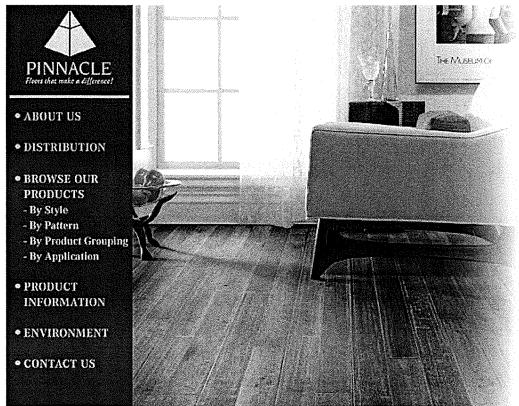
Ms. PARNA A. MEHRBANI LANE POWELL PC 601 SW 2ND AVE STE 2100 PORTLAND, OREGON UNITED STATES 97204-3158

/Joseph W. Berenato, III/

Joseph W. Berenato, III Berenato & White, LLC 6550 Rock Spring Drive, Suite 240

Bethesda, Maryland 20817 Direct: (240) 330-4520

Tel: (301) 896-0600 Fax: (301) 896-0607 Attorneys for Petitioner



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CONTACT US

Click here to contact the nearest dealer/distributor in your area

Home Office

Pinnacle Interior Elements 1434 Patton Place Suite 136 Carrollton, TX 75007 972-418-9400



• PRODUCT

INFORMATION

ENVIRONMENT

• CONTACT US



ABOUT US

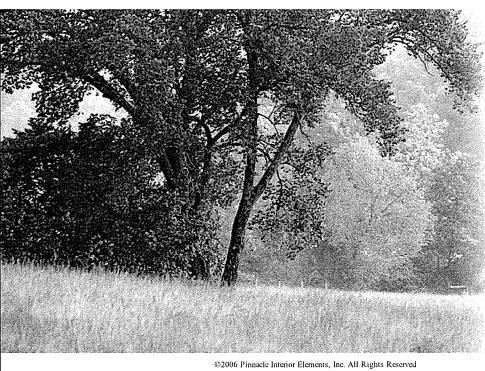
Pinnacle Interior Elements was founded in 1999 to provide the North American floor covering industry with new and innovative products that were not available from existing domestic or other international manufacturers. Pinnacle Interior Elements has developed a series of proprietary product collections that are manufactured in production facilities throughout the world. With over 80 years of experience in the floor covering industry Pinnacle's management team is committed to providing its customers with the highest quality hardwood flooring products available.

Elegantly beautiful and exceptionally durable, Pinnacle Floors form the foundation of style and design for each room in your home, office or place of business. Rich and vibrant color, underfoot comfort, naturally hygienic, environmentally friendly and easy to care for, Pinnacle wood floors are the perfect solution for those who seek fashion, function and affordability.

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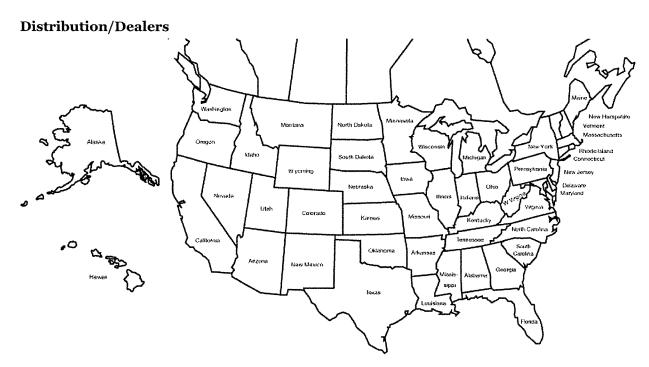
- BROWSE OUR PRODUCTS
- By Style
- By Pattern
- By Product Grouping
- By Application
- PRODUCT INFORMATION
- ENVIRONMENT
- CONTACT US



ENVIRONMENT

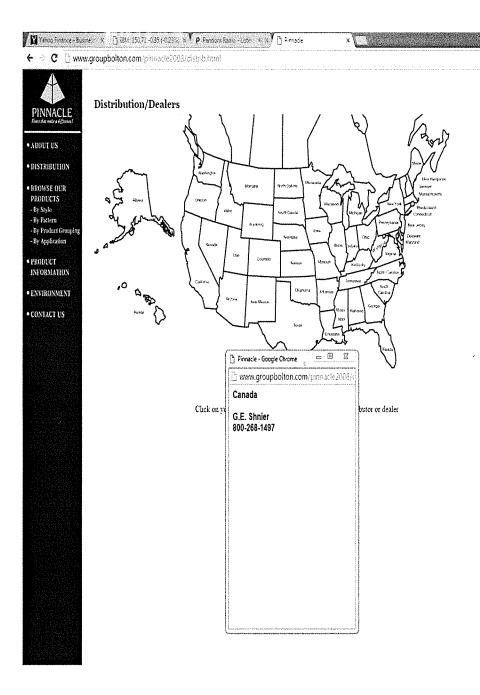
As a national provider of hardwood flooring, we have a deep respect for this precious natural resource. What we use, we use wisely. We pledge our continuous support for reforestation efforts and to preserving the natural wonder of wood for generations to come.





Click on your nearest city/state location to find nearest distributor or dealer

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Product Information - By Style

Distressed/Character Face Products

Centennial Classics Standard Plank Collection
Centennial Classics Wide Width Plank Collection
Country Classics Collection
Estate Classics Collection
Forest Highlands Collection
Forest Ridge Classics Collection
Plantation Classics Collection
Stoneleigh Classics Collection

Distinctive. Timeless. Enduring. The distressed look refers to floors th distinctive natural wood characteristics including knots, burls, minera authenticity to any decorating style. Pinnacle products exhibiting the:

Hand Distressed

Refers to flooring that has been scraped, distressed and sanded by h sculpted irregular surface and thus an aged, worn look and usually l

Machine Distressed

Refers to flooring that has been distressed and sanded by mechanical characteristics and deliver an authentic aged visual, while still prove They usually feature micro-beveled edges.

Smooth Face Products

Americana Plank Collection
Americana Strip Collection
Americana Wide Width Plank Collection
Federal Strip and Federal Plank Collection
Imperial Court Collection
Nature's Elegance Collection

The soft luster of smooth face styling conveys a warm, inviting feeling hardwood flooring expresses elegance and timeless, traditional beauty country and everything in between.

Distressed/Character Face Products

Centennial Classics Standard Plank Collection





ENVIRONMENT

CONTACT US

Product Information - By Pattern

Strip Floors

Americana Strip Collection

Federal Strip Collection

Strip flooring generally refers to flooring consisting of boards that are any construction. It is the long, linear visual that is defined by the term

Plank Floors

Americana Plank Collection

Centennial Classics Classic Plank Collection

Federal Plank Collection

Forest Highlands Collection

Forest Ridge Classics Collection

Nature's Elegance Collection

Plank flooring is defined as boards with a width of 3" or more. At Pinn. 1/2" in width. They deliver a wider and bolder look, one that focuses n

Wide Width Planks

Americana Wide Width Plank Collection

Centennial Classics Wide Width Plank Collection

Country Classics Collection

Estate Classics Collection

Imperial Court Collection

Plantation Classics Collection

Stoneleigh Classic Collection

Wide width planks are those boards that are at least 5" in width and ab centuries in places of distinction and were valued for their great width:

Strip Floors

Americana Strip Collection



3/8" Eng Insta Glua Life 10 Y



Product Information - By Group

Americana Plank & Strip Collection

Americana Plank Collection

Americana Strip Collection

Americana Wide Width Plank Collection

Engineered wood flooring in 2-1/4", 3" and 5" widths. Available in Re sliced face top wood layer for a tighter and more lineal wood grain pat construction for superior milling and structural integrity.

Centennial Classics Collection

Centennial Classics Standard Plank Collection

Centennial Classics Wide Width Plank Collection

Engineered wood flooring in 3" and 5" widths. Available in Oak and Naged and distressed planks combined with a sliced face top wood laye. Micro-beveled edges and ends. Features 7-ply construction for superic

Country Classics Collection

Engineered wood flooring in extra-wide 5" widths. Available in Ash at scrapped rustic visuals and a stocking smooth hand sanded finish adds for tighter and more lineal wood grain patterns. Micro-beveled edges a

Estate Classics Collection

Engineered wood flooring in 1/2" thick by 5" and 6-1/2" extra-wide pl These planks are characterized by an extraordinary multi-tonal colorat The sliced face top layer showcases the exquisite natural graining of so rotary peeled top layers normally used in engineered hardwood floorir

Federal Plank & Strip Collection

Federal Plank Collection

Federal Strip Collection

Traditional hardwood floors crafted in 3/4" thick solid oak, the hallma available in both 2-1/4" wide strips and 3 -1/4" wide planks. Federal S blended together to form an alternating pattern of strips and planks. Ri the perfect foundation for any décor and any room. Micro-beveled edg hardwood flooring is available in a wide selection of rich natural color

Forest Highlands Collection

Solid 3/4" thick by 5" wide Oak or Manchurian Maple hardwood floor and a stocking smooth, hand sanded finish peppered with natural woo ends.

Forest Ridge Classics Collection

Solid 3/4" thick by 3-1/2" wide Oak or Manchurian Maple hardwood I visuals and a stocking smooth, hand sanded finish peppered with natu edges and ends.

Imperial Court Collection

Solid exotic and domestic hardwood flooring 1/2" thick by 5" wide. To for the exciting wood grain visuals. The sliced face top layer showcase versus the repetitive patterns of rotary peeled top layers normally used Sapelli, Sumatran Kempas, Royal Mahogany, Burmese Teak, Huali and

Nature's Elegance Collection

Intrigue abounds in the Imperial Court Collection of exotic natural har bold pattern appropriate for the exciting wood grain visuals. The slice

Pinnacle



Product Information - By Application



Engineered Product Installs On All Grade Levels

Where is the room located that you are considering hardwood for?

Above Grade: Above the outside soil line

If the room is above grade, any Pinnacle product (solid or engineered)

On Grade: On the same level as the original soil line

If the soil line has been cut into a hillside or bermed, it must be consid

Below Grade: Below the outside soil line

If the room is below grade, only Pinnacle engineered products may be

What is the subfloor constructed of?

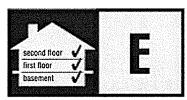
Wood - Planks - OSB (Oriented Stand Board) - Plywood

All engineered and solid Pinnacle floors can be installed over wood su Particle Board

Pinnacle hardwood floors can be glued down over 3/4" particleboard i of 40 lbs.

Concrete

All Pinnacle engineered flooring can be glued down to concrete subfle Natures Elegance collection (a 3/8" thick solid floor) can be glued to c



Engineered Product Installs On All Grade Levels

Engineered Floors

Si

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Americana Plank Collection

<u>Fe</u>

Americana Strip Collection

<u>Fo</u>

Americana Wide Width Plank Collection Centennial Classics Plank Collection

<u>Fo</u> Na

Centennial Classics Wide Width Plank Collection

Country Classics Collection

Estate Classics Collection

Imperial Court Collection

Plantation Classics Collection

Stoneleigh Collection

Americana Plank Collection



Product Information

Care & Maintenance

Finish

Warranty

Americana Strip and Plank Collection Warranty
Centennial Classics Collection Warranty
Country Classics Collection Warranty
Estate Classics Collection Warranty
Federal Strip and Plank Collection Warranty
Forest Highlands, Forest Ridge Collection Warranty
Imperial Court Collection Warranty
Nature's Elegance Collection Warranty
Plantation Classics Collection Warranty
Stoneleigh Classics Collection Warranty
Internet Warranty

Installation Instructions

Care & Maintenance

GENERAL FLOOR CARE INFORMATION

Initial Care – Clean the floor thoroughly by sweeping or vacuuming. L cleaner, following manufacturer directions.

Routine Care – Just sweep or vacuum regularly to remove dust and grin occasionally with Pinnacle Floor Cleaner. Use a soft cloth to apply and with acetone applied to a soft cloth, and then cleaned with Pinnacle Floavoid problems.

Preventive Maintenance — Use small rugs or walk-off mats at all entries Use an area rug in front of kitchen sinks to protect the floor from spills. will not discolor the floor. Do not use area rugs or non-skid rug underla

Use floor protector pads under heavy furniture such as cabinets, dining entertainment centers with feet to reduce the risk of indentation. Felt florecommended to help prevent scrapes and scratches from furniture bein casters versus ball casters to reduce the risk of indentation by distributi

Sweep or vacuum regularly. Never damp mop with water. Water can per Cleaner or other approved wood floor cleaners to remove spills or spot:

Avoid wearing shoes with worn stiletto or spike heels (the type with ex damage the floor. Rolling or sliding heavy objects across the floor can claws should be trimmed regularly as they may scratch the finish of the influenced by the environmental conditions of the room. Temperatures also favorable for hardwood flooring. A temperature of 70° F and a rela humidifier during drier times of the year to help reduce or eliminate ga

